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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,556	10/31/2001	Thomas J. Westbrook	WWWN116621	7679

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EXAMINER

LEVINE, ADAM L

ART UNIT PAPER NUMBER

3625

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/001,556

Applicant(s)

WESTBROOK ET AL.

Examiner

Adam Levine

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29,32-57 and 68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29,32-57 and 68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 10, 2006, has been entered.

Response to Amendment

Applicants' reply dated October 10, 2006, contains certain discrepancies with regard to the status of the claims. Claims 1-57 are not pending. Claims 1-29 and 32-57 are pending, claims 30 and 31 having previously been cancelled. Claims 58-67 were withdrawn without traverse in a response dated June 8, 2004, following an election/restriction requirement mailed May 11, 2004. The office action mailed July 12, 2004, confirmed the election without traverse. These claims should properly have been cancelled in response to the first final office action following the election, mailed July 28, 2005. They are therefore no longer considered to be pending. Claim 68 is new and claim 32 has been amended. Claims 1-29, 32-57, and 68 are therefore pending and considered in this office action.

The amendment filed October 10, 2006, is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The "seller profile" in new claim 68 is new matter and neither the "seller profile" nor the enabling disclosure of a "seller profile" appear anywhere in the specification as originally filed. Likewise, "obtaining a selection of at least one seller corresponding to the buyer criteria from a graphical user interface displaying at least a subset of the set of sellers," is not disclosed or enabled by the specification as originally filed. Specifically, while obtaining a set of sellers corresponding to the buyer criteria is described, the display of a subset of a set is not disclosed in the specification as originally filed.

Applicant is required to cancel the new matter in the reply to this Office Action.

Response to Arguments

Applicant's arguments filed October 10, 2006, have been fully considered but they are not persuasive. Applicants' remarks consist entirely of assertions that have been previously made and addressed. The argument that the prior art fails to teach or suggest "obtaining a confirmation of the completion of a transaction between the buyer and the selected seller," was addressed in the office action mailed July 28, 2005, on page 2. The argument that the Office Action did not establish that the applicants' claims were taught by the provisional application filed September 1, 2000, upon which the prior art reference depends for priority, was addressed in the most recent prior office action,

mailed April 7, 2006, at pages 3-4. The argument that applicants' conception and/or reduction to practice occurred prior to September 1, 2000, and that they proceeded with diligence in filing their provisional application on October 31, 2000, arguments that are unsupported by any submission of evidence, was likewise addressed in the most recent prior office action at page 4.

Pertaining to rejection under 102(e) in the previous office actions

Applicants' argument with regard to Claims 1 and 32, originally filed January 18, 2005, and repeated October 10, 2006, has been fully considered but it is not persuasive. Claims 1-29 and 32-57 remain rejected. Applicants' state:

Specifically, Adam et al. fails to teach or suggest "obtaining a confirmation of the completion of a transaction between the buyer and the selected seller" as recited in the claim.

Unfortunately this is not a correct characterization of Adam (Paper# 050707; US Pub. No. 2002/0069156). Applicants' attention is guided to the following excerpt from Adam previously cited in the first office action:

A further pop-up screen might pertain to order confirmation, through which a buyer might receive an e-mail confirmation that his trading account has been debited once the buyer fills an order, and that the funds have been transferred to an escrow account. A seller might receive e-mail confirmation that a certain quantity of goods have been purchased at a certain price and authorizing release of the product to the shipper. When the trucker delivers the order and it is received and accepted by the buyer, a seller might receive a further confirmation e-mail stating that the funds which the buyer has placed in escrow have now been released to the seller, thereby closing the entire transaction.

(see at least p. 9 para.0068). This very clearly teaches "obtaining a confirmation of the completion of a transaction between the buyer and the selected seller." Applicants' offer no discussion in support of the opposite position so there is no basis for the

Examiner to reverse the prior conclusion. Claims 1 and 32 stand rejected under 35 U.S.C. 102(e) as being anticipated by Adam.

With regard to Claims 2-29 and 33-57, Applicants' state that the claims "recite additional limitations that establish the patentability of the invention over Adam et al." Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Claims 2-29 and 33-57 therefore also stand rejected under 35 U.S.C. 102(e) as being anticipated by Adam.

Applicants argue that that the Office Action has not established that the prior art reference's provisional application filed September 1, 2000, teaches the claims of the present invention. The applicants misunderstand the previous office action. Applicants argue that the examiner cited various portions of the published patent application in response to applicants' request to establish that the provisional application teaches the claims of the present application. This is not correct. All citations given in response to this request in the previous office action were citations to the provisional application. It is noted that they may in fact be quite similar to the published application, but nonetheless they are citations to the provisional application. The following passage is directly taken from the office action dated April 7, 2006.

The examiner has hereby established that the claims of the present invention are taught by the provisional application serial number 60/229,900 dated September 1, 2000. For example, obtaining a buyer transaction request is disclosed at least at page 8 line16- page 9 line 3. Identifying and obtaining a selection of sellers corresponding to buyer criteria and transmitting them is disclosed at least at page 17 lines 1-14. Obtaining a confirmation of the completion of a transaction is

disclosed at least at page 26 lines 6-13. Generating transaction records is disclosed at least at page 28 lines 4-9, and processing the negotiation of a transaction is disclosed at least at page 32 lines 17-20.

All citations are to the provisional application.

With regard to the applicants' unsupported assertion that their conception and/or reduction to practice occurred prior to September 1, 2000, and that they proceeded with diligence in filing their provisional application on October 31, 2000, no evidence has been submitted. This is insufficient to establish a conception of the invention prior to the effective date of the prior art reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). Evidence must also be submitted establishing diligence from a date prior to the date of reduction to practice of the prior art reference to either a constructive reduction to practice or an actual reduction to practice. Finally, evidence must be submitted to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the prior art reference.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claim 68 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The added material which is not supported by the original disclosure is as follows: The "seller profile" is new matter and neither the "seller profile" nor the enabling disclosure of a "seller profile" appear anywhere in the present specification or in the specification as originally filed. Likewise, "obtaining a selection of at least one seller corresponding to the buyer criteria from a graphical user interface displaying at least a subset of the set of sellers," is not disclosed or enabled by the specification as originally filed. Specifically, while obtaining a set of sellers corresponding to the buyer criteria is described, the display of a subset of a set is not disclosed in the specification as originally filed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-29, 32-57, and 68 are rejected under 35 U.S.C. 102(e) as being anticipated by Adam (Paper# 050707; Patent Publication No. 2002/0069156).

Referring to claim 1. Adam discloses a method for facilitating transactions between one or more buyers and sellers, the method comprising:

- Obtaining a buyer transaction request, the transaction request including one or more buyer criteria (see at least paragraph 0078);
- Identifying a set of sellers corresponding to the at least one buyer criteria;
- Transmitting the set of sellers corresponding to the buyer criteria (see at least paragraph 0078 through paragraph 0082);
- Obtaining a selection of at least one seller corresponding to the buyer criteria (see at least paragraph 0078 through paragraph 0082);
- Processing the negotiation of a transaction between the buyer and the selected seller corresponding to the buyer criteria (see at least paragraph 0078 through paragraph 0082);
- Obtaining a confirmation of the completion of a transaction between the buyer and the selected seller (see at least paragraph 0008 and paragraph 0068); and
- Generating transaction records associated with the completed transaction (see at least paragraph 0073).

Referring to claim 2. Adam further discloses a method wherein obtaining the buyer transaction request includes obtaining a buyer transaction inquiry from a buyer computing device, wherein the buyer transaction inquiry includes a request to identify sellers operable to sell a buyer specified product and quantity (see at least abstract).

Referring to claim 3. Adam further discloses a method wherein identifying a set of sellers corresponding to the buyer criteria includes:

- Obtaining product and quantity correlation data (see at least Figure 4, Figure 5 and Figure 6); and
- Translating the buyer specified product and quantity data into a format compatible with each identified seller corresponding to the buyer criteria (see at least Figure 4, Figure 5 and Figure 6).

Referring to claim 4. Adam further discloses a method wherein identifying a set of seller corresponding to the buyer criteria includes applying selection criteria (see at least paragraph 0078 through paragraph 0082).

Referring to claim 5. Adam further discloses a method wherein the selection criterion includes information selecting one or more general seller categories to include/exclude (see at least paragraph 0078).

Referring to claim 6. Adam further discloses a method wherein the selection criterion includes information identifying specific sellers to include/exclude (see at least paragraph 0078).

Referring to claim 7. Adam further discloses a method wherein the information identifying specific sellers to include/exclude is obtained from the buyer computing device (see at least paragraph 0078).

Referring to claim 8. Adam further discloses a method wherein the information identifying specific sellers to include/exclude is obtained from a seller computing device (see at least paragraph 0078).

Referring to claim 9. Adam further discloses a method wherein the selection criterion includes information identifying one or more general seller categories to include/exclude and one or more specific sellers corresponding to the general seller categories to include/exclude (see at least paragraph 0071).

Referring to claim 10. Adam further discloses a method wherein obtaining the buyer transaction request includes obtaining a buyer transaction query from a buyer computing device, wherein the buyer transaction query includes an invitation for offers from a number of sellers (see at least abstract).

Referring to claim 11. Adam further discloses a method wherein identifying a set of sellers corresponding to the buyer criteria includes;

- Identifying a set of sellers corresponding to the buyer criteria (see at least Figure 4, Figure 5 and Figure 6);
- Transmitting the transaction query to the set of sellers (see at least Figure 4, Figure 5 and Figure 6); and
- Obtaining one or more seller offers corresponding to the transaction query (see at least Figure 4, Figure 5 and Figure 6).

Referring to claim 12. Adam further discloses a method wherein identifying a set of seller corresponding to the buyer criteria includes applying selection criteria (see at least paragraph 0078 through paragraph 0082).

Referring to claim 13. Adam further discloses a method wherein the selection criterion includes information selecting one or more general seller categories to

include/exclude from the transaction query (see at least paragraph 0071 and paragraph 0078).

Referring to claim 14. Adam further discloses a method wherein the selection criterion includes information identifying specific sellers to include/exclude from the transaction query (see at least paragraph 0071 and paragraph 0078).

Referring to claim 15. Adam further discloses a method wherein the information identifying specific sellers to include/exclude is obtained from the buyer computing device (see at least paragraph 0071 and paragraph 0078).

Referring to claim 16. Adam further discloses a method wherein the information identifying specific sellers to include/exclude is obtained from a seller computing device (see at least paragraph 0071 and paragraph 0078).

Referring to claim 17. Adam further discloses a method wherein the selection criterion includes information identifying one or more general seller categories to include/exclude and one or more specific sellers corresponding to the general seller categories to include/exclude (see at least paragraph 0071 and paragraph 0078).

Referring to claim 18. Adam further discloses a method wherein obtaining a selection of at least one seller corresponding to the buyer criteria includes:

- Generating a Web page interface (see at least paragraph 0044); and
- Obtaining a selection of the at least one seller via the Web page interface (see at least paragraph 0044).

Referring to claim 19. Adam further discloses a method wherein processing the negotiation of a transaction includes:

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- Obtaining communications from the buyer (see at least abstract); and
- Transmitting the communications to the selected seller (see at least abstract).

Referring to claim 20. Adam further discloses a method wherein processing the negotiation of a transaction includes:

- Obtaining communications from the selected seller (see at least abstract); and
- Transmitting the communications to the buyer (see at least abstract).

Referring to claim 21. Adam further discloses a method wherein processing the negotiation of a transaction includes obtaining a selection of a direction communication method between the buyer and the selected seller; and establishing the direct communication channel between the buyer and the selected seller (see at least paragraph 0025).

Referring to claim 22. Adam further discloses a method wherein the direct communication channel includes an Internet voice communication channel (see at least paragraph 0039).

Referring to claim 23. Adam further discloses a method wherein the direct communication method includes a standard telephonic communication channel (see at least paragraph 0039).

Referring to claim 24. Adam further discloses a method comprising:

- Obtaining a third party transaction request (see at least abstract);
- Identifying one or more third parties corresponding to third party transaction request (see at least abstract);

- Transmitting a set of third parties corresponding to the third party transaction request (see at least abstract);
- Obtaining a selection of at least one third party corresponding to the third party transaction request (see at least abstract);
- Processing the negotiation of a transaction with the selected third party corresponding to the third party transaction request (see at least abstract);
- Obtaining a confirmation of the completion of a transaction with the selected third party corresponding to the third party transaction request (see at least abstract);
and
- Generating transaction records associated with the completed transaction (see at least abstract).

Referring to claims 25 and 26. Adam further discloses a method wherein transaction details are forwarded to a third-party.

The Examiner notes, the descriptive material related to the type of third-party is not functionally involved in the recited steps of the method. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983).

Referring to claim 27. Adam further discloses a method wherein the transaction request is obtained from the buyer (see at least abstract).

Referring to claim 28. Adam further discloses a method wherein the transaction request is obtained from the selected seller (see at least abstract).

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Referring to claim 29. Adam further discloses a method wherein the transaction request is a products transaction request.

The Examiner notes, the descriptive material related to the type of product is not functionally involved in the recited steps of the method. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381 , 1385, 217 USPQ 401, 404 (Fed. Cir. 1983).

Referring to claims 32-57. Claims 32-57 are rejected under the same rationale as set forth above.

Referring to claim 68. Claim 68 is rejected under the same rationale as set forth above. It is noted that the specific term “wood” to describe a product sold is descriptive material and is not functionally involved in the recited steps of the method. Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381 , 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106). The method is the same regardless of the product sold. In addition, Adam discloses:

- seller profile (see at least abstract, figs.5-6, page 1 paras.0005-0006, page 4 para.0032, page 7 para.0053)
- subset of the set of sellers (see at least abstract, page 1 paras.0003-0006, page 4 para.0032, page 7 para.0053)
- agreement (see at least page 2 para.0014, page 12 para.0095).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam Levine whose telephone number is 571.272.8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571.272.6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Adam Levine
Patent Examiner
October 16, 2006



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